

REMARKS

This amendment is submitted in response to the Office Action dated March 22, 2005, in which all of the claims pending in this application were finally rejected as being anticipated and/or rendered obvious by U.S. Patent No. 5,323,545 (Hirano). Specifically, the Examiner rejected claims 1, 7, 11, 13 and 21 under 35 U.S.C. §102(b) as unpatentable as being anticipated by Hirano, and rejected claims 2-6, 8-10, 12 and 14-19 under 35 U.S.C. §103(a) as unpatentable as being obvious over Hirano. In addition, the Examiner rejected all of the claims (1-19 and 21) under 35 U.S.C. §112, first paragraph, based on the alleged failure of the specification to comply with the written description requirement. Applicant respectfully traverses these rejections, and requests reconsideration based upon the amendments to the claims set forth hereinabove and the arguments set forth hereinbelow.

Turning first to the rejections based upon prior art, there are a number of significant differences between applicant's invention and the Hirano reference (the only cited reference that remains in this case, and the one upon which the Examiner has now chosen to place sole reliance). Hirano discloses a sock with a pair of ears or ear-like appendages (intended to imitate the ears of an animal), the ears being formed *integrally* (i.e., as one piece) with the sock body, with the interior of the "ears" being in communication with the interior of the sock body. Hirano also suggests the formation of

an animal face on the exterior of the body of the sock, although it is clear that Hirano intends either that the “face” be positioned immediately adjacent the “ears,” or that there be some physical linkage between the “face” and the “ears,” such that the user perceives the “ears” as a part of, or as a continuation of, the “face.”

Applicant, on the other hand, has disclosed a sock with at least one stuffed three-dimensional object (including a skin and stuffing), not restricted in its shape to the shape of an animal ear, which is formed separately from (and is later attached to) the sock body, with the interior of the object *not* being in communication with the interior of the sock body. These features are now recited in independent claims 1 and 21, as amended hereinabove. Furthermore, applicant’s invention includes indicia on the exterior of the sock body that, while conceptually *related* to the three-dimensional object, is completely self-contained and is separate from that object, *i.e.*, it is *not* physically linked to that object, nor would an observer perceive the object as being a part of, or as a continuation of, the indicia. This feature is recited in new independent claim 22 presented hereinabove.

There can be no question that Hirano discloses only “ear” or “ear-like” attachments, see FIGS. 1, 4-6 and 9 of Hirano, as well as, e.g., column 1, lines 54-61, column 2, lines 6-8 and lines 63-68, column 3, lines 18-19 and line 60, column 4, line 49, etc., and that no attachments *other than* “ears” are disclosed or even suggested. It

is also beyond question that Hirano discloses that the interior of each “ear” is always in communication with the interior of the sock body, see the Abstract and FIG. 3 of Hirano, as well as, e.g., column 1, lines 36-37 and lines 67-68, column 2, line 49, column 3, line 34, column 4, line 47, etc., and that the “ears” are formed integrally with the sock body, see FIGS. 3 and 8 of Hirano, as well as column 1, lines 33-35, column 2, lines 55-56, column 4, line 43, etc.; there is no teaching or suggestion that the “ears” can (or should) be formed *separately*, or that their interiors should *not* be in communication with the inside of the sock body.

Applicant, on the other hand, has recognized that if the three-dimensional stuffed object is *not* formed integrally with, but is formed separately from (and is later simply attached to) the sock body, then that object is not limited by its structure to an ear-like shape, but may be of *any* shape, such as animal, a globe, a die (the singular of “dice”) or even a shape imitative of a cell phone, thereby allowing for a greater “universe” or scope of shapes, and conferring greater commercial versatility on the overall product. Moreover, since applicant’s three-dimensional object is formed separately, its interior need not be in communication with the interior of the sock body, *i.e.*, the restrictions imposed by the requirement of communication in the prior art have been eliminated.

Accordingly, Hirano, with a pair of ear-like appendages, formed integrally with the sock body, with their interiors in communication with the interior of the sock body, does

not anticipate or render obvious applicant's invention as claimed in claims 1 and 21, as presently amended, in which the shape of the object is *not* limited to an ear-like structure, the object is *not* formed integrally with the sock body, and its interior is *not* in communication with the interior of the sock body. Moreover, Hirano, even with an animal face formed on the exterior of the sock body, such that the pair of ear-like appendages are perceived as part of, or as "extensions" or "continuations" of, that face (thereby forming, in effect, a more complete animal "head"), does not anticipate or render obvious applicant's invention as presently claimed in new claim 22, in which it is explicitly recited that the indicia on the exterior of the sock body may be recognized by an observer as complete *without* perceiving the three-dimensional object as a part of, or as a continuation of, that indicia.

In the Office Action (on page 5), in discussing the rejection under 35 U.S.C. §103(a), and referring specifically to claims 2-6, the Examiner asserts that "it would have been an obvious matter of design choice to a person of ordinary skill in the art to have provided the stuffed object being a miniaturized toy, an animal head, an animal, an electronic device or a cellular phone because Applicant *has not disclosed that providing the stuffed object [in one of those forms] provides an advantage, is used for a particular purpose, or solves a stated problem* (emphasis supplied). The Examiner goes on to assert that "it doesn't matter what form [the object] takes," because the object is there simply to "add to the aesthetic appeal of the sock." The Examiner makes similar

assertions on page 6 of the Office Action regarding the various forms of the indicia (a word, a phrase, a number, a fictional character, etc.), as claimed in claims 8-10, 12 and 14-19, as being “an obvious matter of design choice” and as being present simply to add “to the aesthetic appeal of the sock.”

However, the Examiner has conveniently ignored applicant’s teaching in the specification (at page 3, lines 22-23, again at page 5, lines 8-12, and again at page 11, line 5 through page 12, line 7) of the educational value for young children that is associated with providing a stuffed object attached to the sock, along with indicia on the sock body that are visually or textually related to that object. Quite clearly, applicant has disclosed that providing the stuffed object, in one of the disclosed forms or in other forms, along with indicia in one of the disclosed forms (or in other forms), provides an advantage and is used for a particular purpose. Accordingly, the Examiner’s reliance on “design choice” to support the rejection of claims 2-6, 8-10, 12 and 14-19 under 35 U.S.C. §103(a) must fail.

Turning now to the rejection under 35 U.S.C. §112, first paragraph, the Examiner contends that the specification fails to comply with the written description requirement in that it fails to provide support for claimed subject matter (specifically, the limitation added previously to claims 1 and 21 that the “... stuffing conforms to the shape of the object”) in such a manner as to reasonably convey to one skilled in the art that applicant

(the inventor) was in possession of the claimed invention at the time the application was filed. Although the Examiner contends that this limitation was not disclosed in the originally filed specification, drawings or claims, applicant strongly traverses this rejection, noting that this limitation is *inherent* in the drawings of applicant's disclosure (see FIG. 2), when taken in conjunction with the background knowledge that one of ordinary skill in this art would possess.

In the art relating to the provision of stuffed objects (sometimes also known as the field of "plush" toys), it is common knowledge that when a three-dimensional stuffed object is manufactured, the "skin" of the object is formed first, which is then closed up (except for a small aperture), creating a "container" which encloses an interior volume; the "stuffing" is introduced later by inserting it (through the remaining aperture) into the interior of the "container" formed by the skin and filling the interior volume of that container (much as the air inside a balloon conforms to the shape of that balloon as the latter is being inflated), following which the remaining aperture is closed. See, e.g., the description of the background of the invention in U.S. Patent No. 6,109,196, column 1, lines 18-40. If too little stuffing is inserted, portions of the skin will hang limply, while if too much stuffing is inserted, the skin will bulge or look "stretched" and may even burst.

Since the skin is a container that defines the outer limits for, and effectively constrains, the stuffing, it is inherent that the shape taken by the stuffing is *dictated by*

the shape of the skin, *i.e.*, that the stuffing will conform to the shape of the skin (of the three-dimensional object). FIG. 2 of the originally filed drawings discloses this limitation, as it shows the stuffing 26 conforming to the shape of the skin 24 of ornamental object 22. FIG. 2, combined with the reference to “well known techniques for making stuffed objects” in the specification (a statement which the Examiner concedes, on page 7 of the Office Action, is present), is sufficient to reasonably convey to one of ordinary skill in the plush toy art that the stuffing in applicant’s three-dimensional object conforms to the shape of the skin of that object, and that applicant therefore had possession of the claimed invention at the time the application was filed.

The claim amendments made by applicant hereinabove have introduced one (1) new independent claim into this case, whereas this application, as previously amended, contained two independent claims. Therefore, the application now contains a total of three (3) independent claims, or none in excess of the number of independent claims covered by the basic filing fees initially paid for this application.

Nevertheless, the claim amendments made by applicant hereinabove have introduced one additional claim into this case, whereas this application, as previously amended, contained a total of twenty (20) claims. Therefore, the application now contains a total of twenty-one (21) claims, one (1) claim in excess of the total number of claims covered by the basic filing fees initially paid for this application.

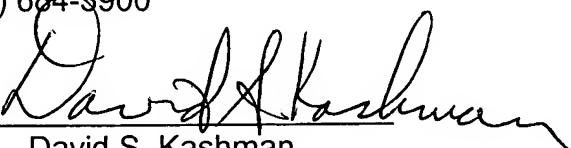
Accordingly, enclosed is a check in the total amount of \$25.00 to cover the additional official filing fee (as prescribed by 37 C.F.R. §1.16(i), in the case of a small entity, for one (1) excess claim in total). The Commissioner is authorized to charge any additional required fees, or to credit any overpayment, to Deposit Account No. 07-1730. A duplicate copy of this paper is enclosed for that purpose.

Applicant has responded herein to each of the points raised by the Examiner in the Office Action, and applicant has explained why applicant believes that all of the pending claims, as presently amended, are patentable over the cited prior art. Accordingly, further favorable action in connection with this patent application is earnestly solicited. The Examiner is invited to contact the undersigned attorney by telephone if it will advance the prosecution of this case.

Respectfully submitted,

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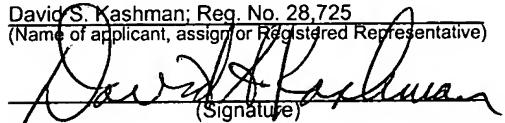
Dated: New York, New York
May 4, 2005

C E R T I F I C A T E O F M A I L I N G

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Date of Deposit May 4, 2005

David S. Kashman; Reg. No. 28,725
(Name of applicant, assignor or Registered Representative)



(Signature)

May 4, 2005
(Date of Signature)